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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,506	03/29/2000	Judith Continelli	10655.9400	6236
7590	07/05/2005		EXAMINER	
Snell & Wilmer L L P One Arizona Center 400 East Van Buren Phoenix, AZ 85004-2202			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/537,506	CONTINELLI ET AL.
	<b>Examiner</b> Firmin Backer	<b>Art Unit</b> 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 April 2005.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 47-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 47-55 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 49 recites the limitation "the second presentment" in line 1. There is insufficient antecedent basis for this limitation in the claim. A first presentment is not previously disclosed

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 47-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Israel et al (U.S PG Pub no. 2004/0210540).

6. As per claim 47, Isreal et al teach a method, implemented on a computer network, for facilitating the manual input of information into a plurality of electronic documents selected from a discrete set of electronic templates, for the purpose of streamlining the resolution of a financial dispute relating to a transaction card transaction, the method comprising the steps of: performing a purchase transaction between a cardmember and a merchant using a transaction card issued to the cardmember by an Issuer, thereafter providing notice by the cardmember to the Issuer that the cardmember disputes the purchase transaction; the Issuer initiating, in response to the notice from the cardmember, a predetermined resolution protocol, wherein the purpose of the protocol is to resolve an ensuing dispute between the Issuer and an Acquirer with respect to a backend processing transaction associated with the purchase transaction, and further wherein the backend transaction involves the Acquirer collecting money from the cardmember and coordinating payment to the merchant for the purchase transaction in accordance with a preexisting backend processing agreement between the Issuer and the Acquirer, wherein the resolution protocol comprises selecting, by the Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, manually inputting into the first template, by the Issuer, information relating to the disputed purchase transaction to thereby generate from the first template a first issuer form; electronically transmitting the first issuer form from the Issuer to the Acquirer; successively selecting additional ones of the templates, by the Issuer and the Acquirer, respectively, to thereby generate additional issuer and Acquirer forms; and electronically exchanging the additional issuer and acquirer forms in accordance with the resolution protocol, and resolving the backend transaction dispute between the issuer and the Acquirer using the issuer forms and the Acquirer form; and in accordance with the resolution

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protocol (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*).

7. As per claim 48, Isreal et al teach a method of retrieving at least one stored file; and attaching the file to the one of at least one of the Issuer forms and Acquirer forms (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*)..

8. As per claim 49, Isreal et al teach a method comprises at least one of Retrieval Request, a First Chargeback and a Final Chargeback, and the Acquirer forms comprises at least one of a Fulfillment and a Second Presentment (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*)..

9. As per claim 50, Isreal et al teach a method comprising selecting, by the Acquirer, a second template from the predetermined set, and manually inputting into the second template information responsive to the first issuer form to thereby generate a first acquirer form; and, electronically transmitting the first acquirer form from the Acquirer to the Issuer (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*)..

10. As per claim 51, Isreal et al teach a method executed in a network computer system for facilitating communication between an Issuer and an Acquirer in the context of resolving a post-transactional dispute, wherein the dispute is between the Issuer and the Acquirer and the dispute is related to an executed credit transaction between a cardmember and a merchant, the executed

credit transaction involving a cardmember's transaction card, the network computer system having a server and at least one access terminal, the method comprising accepting at the server a User ID and password from the Issuer at a first access terminal, retrieving from the server a pre-defined set of Issuer dispute handling forms having pre-defined content which coincide with the User ID; displaying the pre-defined set of Issuer forms at the first access terminal, selecting, by the Issuer, one of the pre-defined set of Issuer forms at the first access terminal; receiving input entered on the selected one of the Issuer forms at the first access terminal', transmitting within the network the one of the Issuer forms to the Acquirer in dispute with the Issuer', notifying the Acquirer at a second access terminal of the one of the Issuer forms; accepting at the server a User ID and password from the Acquirer at the second access terminal', retrieving from the server a set of Acquirer dispute handling forms having pre-defined content which coincide with the Acquirer User ID; displaying the set of Acquirer forms at the second access terminal; selecting, by the Acquirer, one of the Acquirer forms at the second access receiving input entered on the selected one of the Acquirer forms at the second access terminal; transmitting within the network the one of the Acquirer forms to the Issuer; and, notifying the Issuer at the first access terminal of the one of the Acquirer forms (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*)..

11. As per claim 52, Isreal et al teach a method of retrieving at least one stored file from the server; and attaching the file to the one of at least the Issuer forms and Acquirer forms (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*)..

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12. As per claim 53, Isreal et al teach a method of receiving at the second access terminal at least one scanned document computer readable format storing the scanned document on the server; and attaching the scanned document to one of the forms (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*).

13. As per claim 54, Isreal et al teach a method of accepting at the server a User ID and password from a third-party user at a third access terminal, retrieving from the server a set of reports which coincide with the third-party user ID displaying the set of reports at the third access terminal, and receiving instructions from the third party user to transfer monetary liability to at least one of the Issuer from the Acquirer and the Acquirer from the Issuer (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*).

14. As per claim 55, Isreal et al teach a method comprises matching the User ID and password with information stored in a database accessible to the server (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*).

#### *Response to Arguments*

15. Applicant's arguments filed April 14<sup>th</sup>, 2005 have been fully considered but they are not persuasive.

a. Applicant argues that the prior art fail to teach every element in the disclose inventive concept. Applicant further argues that each and every element of independent claim 47 and 51 are not taught in the prior art. Especially the concept of prompting a user

to enter a dispute resolution, selected by the user predefined dispute resolution form, issuer in response to a notice from a cardmember, initiate a predetermined protocol in to resolve an ensuring dispute between the issuer and the acquirer, retrieving from the server a predefined set of issuer handling forms having predefined set of issuer dispute handling form having predefined content which coincide with the user ID .. Examiner respectfully disagrees with Applicant's characterization of the prior art. Israel teach that the dispute party inputs data corresponding to a non-judicial dispute resolution, the system sorts, organizes and compiles the data, and enables the party to avail itself of a full range of non-judicial dispute resolution procedures. The system also allows users of the system to organize data corresponding to multiple disputes, manage that *data into a form selected* by the user, and generate reports based on the data from one or more disputes that have been input into the system to which they are a party. The present system allows parties to disputes to effectively and efficiently input, sort, organize and manage the data corresponding to disputes, and resolve disputes via the internet. Israel further teaches that before any Program User may begin to enter disputes into the system, they must be given access to the system by the Program Manager. The Program Manager clicks on the "Add User" icon on the Program Manager Page to access the Add User Form. The Add User Form prompts the Program Manager for the input of relevant Program User information such as name of the user, department, telephone number, e-mail address, etc. After a Program User selects to add a dispute, they are then prompted to select a profile classification 58 as either a plaintiff or a defendant. After selecting the appropriate profile, the user is then prompted to select from a displayed general list the nature of the dispute. *The general nature of the dispute can be a general dispute, a bad loan, a*

*business transaction, construction, contract, credit card, foreclosure, labor and employment, landlord/tenant, lender liability, partnership agreement, personal injury, professional liability, purchase and sale transaction, rental agreement, intellectual property, subrogation, worker compensation, or any other cause of action recognized by a judicial system, whether in the United States or abroad.* Once the opposing party receives notification that a dispute has been entered into the system, they can respond to the submitted dispute in several ways. Before responding, however, the opposing party must have their access code and dispute code. Without these, the opposing party cannot access the system. The opposing party, with access and dispute code in hand, uses the web browser of their computer to locate and retrieve the web site for the present system as described above. After accessing the web site, the responding party is prompted to either utilize the settle-only access (if not already a Program Manager/User of the present system), register a new account with the system and establish themselves as a Program Manager/User, or indicate that they are not interested in utilizing the present system to conduct negotiations of any kind. Further, the responding party (whether plaintiff or defendant) may not agree to utilize the present system to resolve the dispute. If the responding party so desires, they may click on the "Not Interested" icon. If the responding party is not interested, the present system will notify the submitting party via e-mail that the responding party is not interested in negotiating via the system.

- b. As for claims 47-55, they are not in compliance with 35 U.S.C 112 and are not allowable over the art of record. Furthermore, as indicated, Israel teaches every element

in the disclosed inventive concept. Therefore the rejection is maintained and the action is made final.

***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

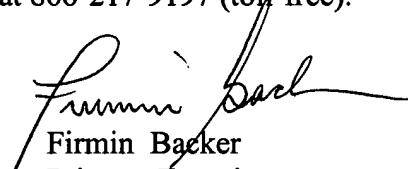
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (571) 272-6703. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer  
Primary Examiner  
Art Unit 3621

June 27, 2005